

REMARKS

Claims 1 - 17 are presently in the subject application.

Claims 1-6, 9-17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Whitcomb, U.S. Patent No. 6,011,049 ("WHITCOMB"). It is respectfully submitted that these claims are not obvious in view of WHITCOMB.

The deficiencies of WHITCOMB presented in Applicants' Response to the Office Action of January 3, 2002, are reiterated hereat. As previously discussed, WHITCOMB reveals conventional delivery systems, such as tablets, capsules, etc. (WHITCOMB, col. 4, lines 35-41; col. 5, lines 28-33). WHITCOMB does not reveal or recognize the critical considerations involved in the subject invention, namely, the relative concentrations of each drug, the dose requirement of pioglitazone vis-a-vis metformin and the comparative solubility rates and absorption rates of each drug (the subject specification, at page 3, first through fourth full paragraphs). WHITCOMB does not reveal or hint at the unitary core formulation as defined by Applicants.

One of ordinary skill in the art in viewing WHITCOMB would understand and appreciate that WHITCOMB is only revealing a conventional "combination therapy", which involves administering two or more drugs separately. Combination therapy does not involve a mixture of two or more drugs and certainly, not the core formulation as defined by Applicants.

Reference in this regard is made to WHITCOMB, at Figure 8 ("combination therapy"); Figure 11 ("combination therapy"); Figure 12 (... "Combination Therapy"); col. 1, lines 33-34 ("It has now been discovered that **combination therapy** ..." (emphasis added); col. 2, lines 6-26 ("FIG. 8 ... metformin and troglitazone **combination therapy**" ... FIG. 11

...metformin ... troglitazone ... of combination therapy ... FIG. 12 ... metformin and troglitazone ... **combination therapy** ... (emphasis added)); col. 4, lines 38-41 ("In a preferred embodiment, the sulfonylurea, biguanide, and glitazone are formulated **individually** and administered in the same manner that each is normally used clinically." (emphasis added)); col. 6, lines 6-13 ("Overview ... troglitazone/glyburide **combination therapy** ... Patients treated with **combination therapy** ... (emphasis added)); col. 6, lines 53-54 ("... A greater number of patients treated with troglitazone **combination therapy** ... (emphasis added)); col. 11, lines 2-3 ("... **combination therapy** of troglitazone and sulfonylurea appears to be safe ..." (emphasis added)); col. 11, lines 15-17 ("CONCLUSIONS Troglitazone/glyburide **combination therapy** is well tolerated ..." (emphasis added)); and col. 15, lines 21-24 ("After the initial ... period ... the remaining subjects were **dosed** with a combination of metformin and troglitazone (1000 mg metformin **BID**, 400 MG troglitazone **QD** ..." (emphasis added)).

One of ordinary skill in the art would not be led to Applicants' core formulation from a view of WHITCOMB.

The Examiner states that:

WHEREAS Whitcomb does not teach a first layer and a core covered by at least a portion of the first [layer], it is **understood** by the Examiner that in the combination of piolitazone and metformin, portions of pioglitazone would cover metformin. (emphasis added).

Firstly, a question to be asked is **from what or whom** does the Examiner obtain his understanding. The Examiner has presented not a single authority to establish that such is true. Certainly, a core, at least a portion of which is enclosed by said first layer is not disclosed or hinted at by the "combination of pioglitazone and metformin". *In re GPAC*, 57 F.3d 1573, 35

U.S.P.Q. 2d 1116, 1123 (Fed. Cir. 1995). *Ex parte Yamamoto*, 57 U.S.P.Q. 2d 1382, 1383-1384 (BPAI 2000).

Secondly, nowhere in WHITCOMB is an **actual** combination of pioglitazone and metformin described. Accordingly, in this regard, certainly the Examiner's understanding could not have come from conjecture?

A "core" is defined in "Webster's Third International Dictionary", (1993) (copy enclosed) as "the central and often fundamental part of a body, mass or construction as distinct from the enveloping part of a difference in nature or by being cut out or separated ..." A "layer" is defined in this dictionary as "a. one thickness, course or fold laid or lying over or under another ... b. stratum, bed ...". Accordingly, **arguendo** assuming that this fertile, imaginative understanding is valid, the "combination" does not form particles which are a core of metformin i.e. a central part of a body, and the pioglitazone does not form a layer "laid or lying over" a portion of a core.

One of ordinary **skill** in the art would not consider or imagine mixed particles as being a core having a layer on a portion thereof. *In re Way*, 514 F.2d 1057, 185 U.S.P.Q. 580, 584 (CCPA 1973).

It is respectfully submitted that claims 1-6, 9-17, are not obvious, under 35 U.S. (§ 103(a), to one of ordinary skill in the art in view of WHITCOMB and allowance of these claims is requested.

Claims 1-17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Rieveley, U.S. Patent No. 6,153,632 ("RIEVELEY"). It is respectfully submitted that these claims are not obvious in view of RIEVELEY.

The deficiencies of RIEVELEY discussed in Applicants' Response to the Office Action mailed on January 3, 2002, are reiterated hereat. Why would one of ordinary skill in the art be led to Applicants' invention as defined in claims 1-17 when RIEVELEY does not reveal or hint at a core formulation; (2) reveals only conventional delivery vehicles (RIEVELEY at col. 6, lines 41-61); (3) does not appreciate the criticality considered in Applicants' inventive core (the subject specification at page 3, first through fourth full paragraphs, especially the fourth full paragraph).

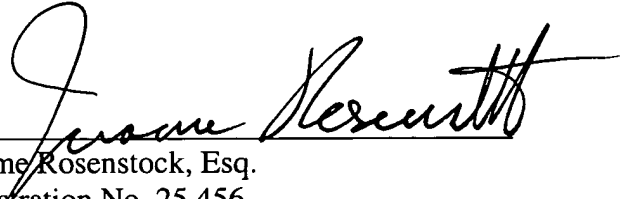
It is respectfully submitted that claims 1-17 are not rendered obvious, under 35 U.S.C. § 103(a), in view of RIEVELEY and allowance of these claims is requested.

In the event the Examiner maintains his final rejection, enclosed is a Notice of Appeal to this rejection.

The Examiner is hereby authorized to call the undersigned attorney of record "collect" on any matter connected with this application. The telephone number is 212-588-0800. In the absence of the undersigned attorney of record, the call will be accepted by any attorney empowered in this application.

Respectfully submitted,

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Webster's
Third New
International
Dictionary

UNABRIDGED

[illegible]

Two classical columns are shown. Column A is a fluted column with a composite capital, supporting a heavy entablature with a prominent cornice. Column B is a fluted column with a composite capital, supporting a lighter entablature with a prominent cornice.

